

**REMARKS**

Claims 1-45 and 58-76 are pending.

Applicants respectfully submit that no new matter has been added by way of the present amendment. For instance, certain claims have been amended to reflect the order of layers according to the heat-setting label sheet of the present invention. Claim 1 has been amended to include an image receiving layer as supported by originally filed claim 2. Claim 2 has been amended as necessitated by the amendment to claim 1. Claim 8 was amended to clarify that a barrier layer may be added between the support and the pressure sensitive adhesive layer as supported by the present specification at, for example, page 4, lines 5-6. Claim 9 was amended to clarify the nature of an Adhesion Layer according to the present invention.

New claims 63 and 64 are supported by originally filed claims 1 and 2. New claims 65-70 are supported by originally filed claims 1, 2, 46 and 54. New claims 71-73 are supported by originally filed claim 1. New claim 74 is supported by originally filed claim 1, Figure 1 and the description at page 48, line 29 to page 49, line 12. New claim 75 is supported by the present specification at page 4, lines 13-17, page 13, lines 20-25 and page 15, lines 20-26. New claim 76 is supported by originally filed claim 1 as well as the present specification at page 4, lines 13-17, page 13, lines 20-25 and page 15, lines

20-26. Lastly, non-elected "method" claims 46-57 have been cancelled. Accordingly, no new matter has been added.

In view of the following remarks Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Status of claim 20

Applicants respectfully request that the Examiner clarify the status of claim 20. In particular, Applicants request that the Examiner confirm whether claim 20 is under examination or withdrawn from consideration.

Issues under 35 U.S.C. § 112, first paragraph

The Examiner has rejected claims 1-3, 5-9, 11, 12, 14, 15, 17-20, 24, 32-45 and 58-62 under 35 U.S.C. § 112, first paragraph for the reason recited at pages 3-4 of the outstanding Office Action. Applicants respectfully traverse this rejection.

The Examiner asserts that the order of layers must be recited in the claims. In order to expedite prosecution, Applicants have amended the relevant claims to recite the order of layers in the present heat-setting label sheet. Reconsideration and withdrawal of this rejection are respectfully requested.

Issues under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-3 and 5-8 under 35 U.S.C. § 103(a) as being obvious over Laprade et al., USP 6,099,944 (hereinafter referred to as Laprade '944). Applicants respectfully traverse this rejection.

Laprade '944 discloses a heat-transfer label having a substrate coated with a polyethylene film, which is coated with a skim coat of wax, which is coated with a protective lacquer layer, which is coated with an ink design layer, and which is coated with a heat-activated adhesive layer. See col. 6, lines 54-67 of Laprade '944. By making reference to each of these layers, the Examiner attempts to reject the present claims.

Referring to claim 1, Applicants remind the Examiner that the present heat-setting label sheet comprises:

- (i) a support;
- (ii) a pressure sensitive adhesive layer coated on said support, said pressure sensitive adhesive layer comprising at least one material selected from the group consisting of: (a) a polyester having a glass transition temperature (Tg) of less than 0°C, (b) an acrylic polymer having a glass transition temperature (Tg) of less than 0°C, and (c) a copolymer blend having a glass transition temperature (Tg) of less than 0°C;
- (iii) an Adhesion Layer coated on said pressure sensitive adhesive layer, said Adhesion Layer comprising at least one

material selected from the group consisting of a thermoplastic polymer which melts in the range of 50-250°C, a wax which melts in the range of 50-250°C, and combinations thereof, wherein the adhesive layer is capable of being removed from the support without heat;

(iv) a first optional opaque layer coated on said Adhesion Layer;

(v) a second optional opaque layer coated on said first optional opaque layer (iv) or on said Adhesion Layer; and

(vi) an image receiving layer on said Adhesion Layer or on said first and/or second optional opaque layers, when present.

To summarize the required components, the present heat-setting label sheet of claim 1 comprises, in this order, a support, a pressure sensitive adhesive layer, an adhesion layer, optional first and second opaque layers, and an image receiving layer.

The Examiner asserts that the "ink design layer and wax" of Laprade '944 reads on the present adhesion layer (see page 5, first paragraph of the outstanding Office Action). Further, the Examiner asserts that the "protective layer" of Laprade '944 reads on the instant image receiving layer (see page 5, last paragraph of the outstanding Office Action). Based upon this characterization alone, the Examiner's rejection fails.

First, the "ink design layer" and the "wax layer" (the skim

coat) of Laprade '944 are separated by the protective lacquer layer, therefore, they cannot be construed as the same layer.

Second, the "protective layer" of Laprade '944 (allegedly corresponding to the present image receiving layer) is coated beneath the ink design layer of Laprade '944 (allegedly corresponding to the present adhesion layer). However, the present adhesion layer is coated beneath the present image receiving layer.

Third, Laprade '944 fails to suggest or disclose a pressure sensitive adhesion layer coated between the support and an adhesion layer. The Examiner points to column 3, lines 43-67 of Laprade '944 as disclosing a pressure sensitive layer between the support and the ink layer. However, this is incorrect. At the location cited by the Examiner, Laprade '944 discloses:

Largely for aesthetic reasons, it has become increasingly more common in the bottling of wines and the like to use a glass bottle having a frosted, opaque or hazy appearance--as compared to a clear or transparent appearance. Typically, such glass bottles are given a frosted appearance by a chemical etching process (typically by exposing the glass bottles to a strong acid) or by a mechanical abrading process (e.g., by sandblasting the glass bottles). One problem that has been encountered in labelling such frosted glass bottles is that the application of a label to the bottle tends to negate the frosted effect of the bottle in those areas in which the label covers the bottle, thereby causing any open-copy areas of the label to appear clear, instead of frosted. As can readily be appreciated, such a result is undesirable from an aesthetic viewpoint. Consequently, various approaches have been taken to make the bottle appear frosted in the open-copy areas. One such approach has been to use

a pressure-sensitive label in which a layer of frosted material is interposed between the ink design layer and the pressure-sensitive adhesive layer. Although this approach substantially ameliorates the aforementioned loss of the frosted effect caused by labelling, the use of a pressure-sensitive label of the foregoing type introduces other aesthetic shortcomings typically associated with pressure-sensitive labels in general.  
(emphasis added).

Although Laprade '944 does disclose a pressure sensitive adhesive layer, Applicants submit that the disclosure amounts to a negative teaching. In particular, Laprade '944 discloses that the use of a pressure sensitive layer introduces aesthetic shortcomings. Clearly, this removes any motivation to utilize a pressure sensitive adhesive layer in connection with the material of Laprade '944.

The Examiner further attempts to assert that a pressure sensitive adhesion layer is known in the art and cites Mesek et al., USP 3,920,016. Mesek relates to a disposable diaper and thus Applicants submit that it represents non-analogous art. Even if analogous, one of skill in the art would not supplement the disclosure of Laprade '944 with the pressure sensitive adhesive layer Mesek in view of the negative teaching of Laprade '944.

In summary, Applicants respectfully submit that the present claims are patentable over the cited art of Laprade '944. Reconsideration and withdrawal of this rejection are requested.

The Examiner has also rejected claims 9, 11, 12, 14, 15, 17-

20, 24, 32-45 and 58-62 under 35 U.S.C. § 103(a) as being obvious over Laprade '944 in view of Kronzer, USP 5,798,179 (hereinafter referred to as Kronzer '179). Applicants respectfully traverse this rejection.

The Examiner has used the disclosure of Kronzer '179 to supplement the compositions of various layers according to Laprade '944. However, as discussed above, Laprade '944 fails to suggest or disclose the basic combination of layers according to the present invention. Kronzer '179 fails to cure these deficiencies, regardless of the disclosure of various compositions. Accordingly, this rejection is improper. Reconsideration and withdrawal thereof are requested.

In view of the above, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

9

Claims 59-60

At page 9, second full paragraph, the Examiner has apparently objected to claims 59-60, stating that they appear to be directed to the use of the heat-setting label sheet of claim 1 and therefore should be changed to method of use claims. Applicants traverse and submit that claims 59-60 are not method of use claims, but rather "kit" claims. Kit claims are fully acceptable claim practice and should be provided action on the

merits without amendment.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a two (2) month extension of time for filing a reply in connection with the present application, and the required fee of \$210.00 is attached hereto.

If the Examiner has any questions or comments, please contact Craig A. McRobbie, Registration No. 42,874 at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP


By



Marc S. Weiner  
Reg. No. 32,181

Craig A. McRobbie  
Reg. No. 42,874

Post Office Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

  
MSW/CAM: bmp  
0175-0284P